

REMARKS/ARGUMENTS

Applicant has carefully reviewed and considered the Office Action mailed on June 10, 2010, and the references cited therewith.

No claims are amended, claims 10-11 and 20-21 are canceled, and no claims are added. Claims 1-9, 12-19, and 22-24 are pending in this application.

Examiner's Interview Summary

Applicant thanks Examiner Tyson for conducting a brief interview by phone on August 10, 2010 to discuss the present application. During this interview the arguments in response to the 103 rejections were discussed. Applicant appreciates that Examiner Tyson indicated that the arguments were persuasive in response to the 103 rejections. There was a helpful dialogue such that Applicant believes the present claims are in patentable order.

§ 112 Rejection of the Claims

Claims 1-9, 12-19, and 22 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The Office Action alleged the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses the rejection as follows.

The Office Action, having a mail date of 06/10/2010, states that “at the time the application was filed, the applicant failed to disclose concentric loops on ‘only’ an outside surface of the structure material as recited in claim 1, or RF markers located ‘only’ on an outside of the peripheral surface of the structure as recited in claim 13” (Office Action, page 3).

Applicant notes that support for the claims can be found, at least, in paragraphs 28 and 30 of the present specification.

For instance, paragraph 28 discusses RF markers with multiple winding loops that do not directly enclose water molecules, but the water molecules are located closely proximate or adjacent the multiple winding loops. Paragraph 28 provides that these types of markers can be used on devices like catheters.

Additionally, paragraph 30 discusses that the multiple windings can be provided by different techniques, including conductive ink.

In describing the multiple winding loops, the multiple winding loops could be conductive ink and be used on a device like a catheter, thus describing RF markers located only on an outside of the peripheral surface of the structure.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 112 rejection of independent claims 1 and 13, as well as those claims that depend therefrom.

§103 Rejection of the Claims

Claims 1, 2, 4-9, and 13-19 were rejected under 35 USC § 103(a) as being unpatentable over Anderson, et al. (U.S. Patent No. 5,800,526) and Melzer, et al. (U.S. Patent No. 6,847,837 B1). Applicant respectfully traverses the rejection as follows.

Anderson does not appear to teach or suggest each and every element as provided in Applicant's independent claims 1 and 13. Furthermore, Melzer does not appear to cure the deficiencies of Anderson.

The Office Action states that "Anderson fails to disclose the markers may include RF markers that form generally concentric loops of conductive material on only an outside surface, or peripheral surface, of the structure to delineate an outer circumference of the cells" (Office Action, page 4). Applicant agrees.

The Office Action then suggests that Melzer discloses what Anderson fails to disclose. However, Applicant disagrees that Melzer discloses “the markers may include RF markers that form generally concentric loops of conductive material on only an outside surface, or peripheral surface, of the structure to delineate an outer circumference of the cells”.

Melzer appears to teach, relating to figures 4 and 5, that resonance circuits, each including an inductor and a condenser, are disposed on the lateral surfaces of an invasive instrument (column 9, line 62 through column 10, line 20; figures 4 and 5) and that a spiral shaped coil arrangement is provided on each side of a square shaped instrument (column 10, lines 8-13, figure 5).

In contrast to Anderson and Melzer, either alone or in combination, Applicant’s claim 1 provides, in part, “radio frequency (RF) markers that form generally concentric loops on only an outside surface of the structural material to respectively delineate an outer circumference of the first cell and an outer circumference of the second cell” and Applicant’s claim 13 provides, in part, “radio frequency (RF) markers located only on an outside of the peripheral surface of the structure that respectively delineate outer circumferences of the two or more cells of the structure to emit sufficient RF energy under MRI visualization to disturb hydrogen atom spins of at least one voxel”.

Additionally, Anderson provides that the expansion properties of stainless steel make it a preferred material for the stent (column 6, lines 59-60). Anderson then states that these special expansion characteristics provide properties that allow the stent to perform its intended purpose (affix about aneurysm) (column 8, lines 25-32). Anderson goes on to recite stainless steel in numerous places, such as column 8, lines 49-68, column 9, lines 1-5, column 9, lines 16-20, and column 9, lines 51-61. Anderson provides 3 methods of forming the stent: 1) chemically etching a sheet of stainless steel (column 9, lines 16-26); 2) electronic discharge machining of the stainless steel stent (column 9, lines 3-41); and 3) laser cutting the stent from a piece of stainless steel (column 9, lines 43-50). It appears that stainless steel is critical to

Anderson's stent both for its special expansion characteristics and as the sole material Anderson discloses for the stent.

However, stainless steel is a ferromagnetic material having a high magnetic susceptibility. These materials result in artifacts when employed in MRI procedures, and are thus unsuitable for MRI.

It does not appear that one would modify Anderson, which is unsuitable for MRI, with the resonance circuit of Melzer, which is intended for MRI use.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of independent claims 1 and 13, as well as those claims that depend therefrom.

Claim 3 was rejected under 35 USC § 103(a) as being unpatentable over Anderson, et al. (U.S. Patent No. 5,800,526) and Melzer, et al. (U.S. Patent No. 6,847,837 B1) as applied to claim 1 above, and further view of Doran, et al. (U.S. Publication No. 2002/0055770 A1). Applicant respectfully traverses the rejection as follows.

Claim 3 depends from independent claim 1. For the reasons stated above, Applicant respectfully submits that independent claim 1 is in condition for allowance.

From Applicant's review of Doran, Doran does not cure the deficiencies of Anderson and Melzer. That is Anderson, Melzer, and Doran, alone or in combination, do not teach or suggest each and every element provided in Applicant's independent claim 1, as currently amended.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection of dependent claim 3.

Claims 12 and 22 were rejected under 35 USC § 103(a) as being unpatentable over Anderson, et al. (U.S. Patent No. 5,800,526) and Melzer, et al.

(U.S. Patent No. 6,847,837 B1) as applied to claims 1 and 13 above, and further view of Jackson, et al. (U.S. Publication No. 2003/0004563). Applicant respectfully traverses the rejection as follows.

Claims 12 and 22 depend from independent claims 1 and 13 respectively. For the reasons stated above, Applicant respectfully submits that independent claim 1 is in condition for allowance.

From Applicant's review of Jackson, Jackson does not cure the deficiencies of Anderson and Melzer. That is Anderson, Melzer, and Jackson, alone or in combination, do not teach or suggest each and every element provided in Applicant's independent claims 1 and 13.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection of dependent claims 12 and 22.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's below listed attorney at (612) 236-0125 to facilitate prosecution of this matter.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being electronically filed with the United States Patent and Trademark Office on this 10 day of September, 2010.

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